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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/976,579	11/24/1997	JAMES D. THORNTON	JAO-34191	2070

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EXAMINER

BROWN, CHRISTOPHER J

ART UNIT

PAPER NUMBER

2131

DATE MAILED: 09/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

08/976,579

Applicant(s)

THORNTON ET AL.

Examiner

Christopher J Brown

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

### **DETAILED ACTION**

1. Applicant's request for reconsideration of the last Office action is persuasive and, therefore, the finality of that action is withdrawn as of August 9 2002 in interview with Mr. Richard S. Elias. This subsequent action is hereby issued as a final rejection.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurokawa U.S. patent no. 4,811,111 in view of Zdybel U. S. patent no. 5,486,686.

4. As per claims 1, 10 Kurokawa illustrates a facsimile machine that produces and processes a paper document, see Column 2 lines 60 to Column 3 line 6. The facsimile machine is able to encode data. As no specific definition for encode was listed by the applicant, the examiner used the broadest definition of encode allowable. To encode is to convert from one system of communication into another, see Merriam-Webster's Collegiate Dictionary tenth edition pg. 380. After encoding, the facsimile sends the data to another facsimile where it is decoded, see Column 2 lines 51-59, Fig 1. As no specific definition for decode was listed by the applicant, the examiner used the broadest

definition allowable. To decode is to convert (as a coded message) into intelligible form see Merriam-Webster's Collegiate Dictionary tenth edition pg. 299. After decoding, the receiving fax prints the information it has recovered, see Column 3 lines 7-10. Kurokawa does not disclose use tokens, hence Kurokawa does not disclose use of a function generator, encoding tokens, or printing encoded tokens.

5. A token is defined as reference and access information of the instant specification see Page 2 lines 10-11. Zdybel illustrates a system capable of storing an entire document, a portion of a document, references, and access information see Col 4 line 64 – Col5 line 2. Therefore the examiner asserts that the machine code used in Zdybel constitutes a token. The examiner also asserts that Zdybel shows an encoder that encodes tokens, see Column 8 lines 38-47.

6. Zdybel fails to explicitly discuss the steps generating a token. However, it is implicit in the reference that there is a token generator, since a token cannot exist without first being generated. To facilitate transport these encoded tokens are printed on hardcopy paper documents for the user, see Column 8 lines 45-50.

After printing, the document is used by a person. The diversity of data that can be included in tokens, illustrates the possibility of multiple tokens on a paper, see, Zdybel column 4 lines 64 to Column 5 line 2, Column 9 line 13-14. Each type of data is used for a different purpose. Examples can be found in the listed citation. For instance, a file name would give the user an idea of what file to select when printing. Printing histories would give the user an idea of how many hardcopies are currently in the office. Modification dates would let the user know the last time the document had been altered.

Access and security information would give the user the information on how to access the e-document info including possible authentication information. The examiner asserts that a user would be able to select one or more tokens from the list embedded in the paper

7. In combining Kurokawa with Zdybel a new system is formed in which a document with embedded encoded tokens is sent through a facsimile to another facsimile and printed out on paper. In this process the tokens are generated, and encoded to machine readable form to embed in paper documents. Once the new document is printed, the facsimile will encode it for transport. When the receiver facsimile machine recovers the document after transmission, it will decode it. The document will then be printed out for the user. Since the document printed by the facsimile looks and functions the same as when it was printed in Zdybel, it is possible for the end user to access all the information on the said paper document including embedded tokens. Motivation for modifying Kurokawa to include the elements of tokens found in Zdybel can be found in the need to distribute the information quickly from user to user. The facsimile provides nearly instant transmission of a document and is one of the fastest methods of document delivery available. Therefore Claims 1,10 are rejected.

8. Since claim 19 is a method version of claim 1, they perform the same function. Claim 19 is rejected on the basis of the rejection for claim 1 in the paragraphs above.

9. As discussed above, a combination of Kurokawa and Zdybel illustrate a facsimile machine system that produces and processes a paper document see, Column 2 lines 60 to Column 3 line 6. The system has a scanner in the form of the transmitting facsimile that reads an entire document. A token makes up a portion of this document. Within the

system the receiving fax receives image data from the transmitting fax as written above.

The examiner asserts that information on the entire document is identified from the information transmitted, and decoded by the receiving fax. The receiving fax generates a list of tokens as seen in written rejection of claim 1. A selector that allows a user to select decoded tokens exists also as written in rejection of claim 1, see above. Therefore claim 28 is rejected.

10. As per claim 2, Kurokawa discloses that his transmitting facsimile machine has a scanner capable of reading documents. The examiner asserts that use of the fax machine in the Kurokawa-Zdybel combination would include tokens, see Column 3 lines 3-6. Zdybel also indicates a scanner capable of reading encoded tokens printed out the receiving fax of the Kurokawa-Zdybel combination, see Col 9 lines 46-53, Fig. 5 (154, 161). Therefore Claim 2 is rejected.

11. As per claim 3,4 Zdybel does not explicitly state said processor, so he does not state the processor retrieves electronic documents based on recognized tokens. He does state that electronic documents are recaptured for use on a workstation see Col 10 line 56-line 64, Col 9 lines 21-32. The citation of column 9 also provides examples of glyph recognition. The examiner asserts that all machine code is read in a similar manner so that the recognition and retrieval of tokens would work in the same manner as electronic document retrieval. Both the tokens, and the electronic documents are presented in the form of glyphs. It has already been stated in preceding paragraphs that the Kurokawa-Zdybel includes tokens, see Col 4 lines 64- Col 5 line 2, Col 5 lines 48-54. Therefore Claim 3,4 are rejected.

12. As per claim 5, Zdybel discloses human readable information intermixed with encoded tokens, see Col 9 line 21-27. Also, tokens in Zdybel may include entire electronic version of printed document see Col 8 lines 39-50, Fig 5. Therefore Claim 5 is rejected.

13. As per claim 6, Zdybel discloses the use of memory that stores electronic documents, see Fig 5, Col 10 lines 53-56. Kurokawa also has memory to store the generated glyphs, see Col 2 59-61. The examiner asserts that the tokens and e-documents are both stored in memory in the same manner. The examiner also asserts if there were no memory, the tokens would not be able to exist in a system with computers. Therefore Claim 6 is rejected.

14. As per claim 7, Zdybel discloses that the machine code may include names and dates, access and security info, Col 4 line 64- Col 5 line 2. The examiner asserts it would have been obvious to include owner information as part of access and security. The owner would want to control usage to the document and thus the access and security. Therefore Claim 7 is rejected.

15. As per claim 8, Zdybel discloses that the machine code, which includes tokens, may be encrypted, see Claim 11. Zdybel fails to disclose that human readable text is encrypted. The examiner therefore asserts that it would have been obvious that the encoder perform the action of encoding, and encrypting. The encoder is the only device disclosed which processes the tokens into encoded form. Therefore Claim 8 is rejected.

16. As per claim 9, the examiner asserts authentication is one well known area of access and security, and the examiner takes official notice of such. Access and security

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are disclosed in Zdybel, see Col 4 line 64- Col 5 line 2. If the owner wanted to grant access to a document or data, the examiner asserts that authentication would be an obvious method of doing so. Therefore Claim 9 is rejected.

17. Claims 11-18 are on the basis of claims 2-9. Claims 11-18 are therefore rejected.

18. Claims 20-27 are method versions corresponding to claims 2-9. Claims 20-27 are therefore rejected.

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.




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*Conclusion*

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher J. Brown whose telephone number is 703-305-8023. The examiner can normally be reached on 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gail Hayes can be reached on 703-305-9711. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Brown, Christopher J.  
August 15, 2002

  
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